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Docket No. YOR920030013US1
(YOR.427)

REMARKS

Applicants concurrently file herewith a Request for Continued Examination, a Petition for a one-month extension of time, and corresponding fees.

Claims 1, 2, 5, 6, 11, 12, 14, 15, 17, 19-23, 25, 26, 32, and 33 are all of the claims presently pending in the application. Applicants have not amended the previously pending claims.

Applicants maintain the position set forth in Request for Reconsideration filed on April 8, 2009.

In responding to Applicants previous arguments, the Examiner alleges, “[o]nce the Examiner has found evidence of *prima facie* case of obviousness (*sic*), the burden has shifted to Applicant to prove that the combination of fluorine and bromide-containing gas, or a combination thereof (*sic*), would have made the invention of Kamata inoperable.” (See Advisory Action dated May 19, 2009 at continuation page). The Examiner, however, is clearly incorrect.

That is, assuming the Examiner actually established a *prima facie* case of obviousness, then the burden shifts to the Applicant to rebut that *prima facie* case. Applicants, however, are not required to establish that the invention of Kamata would be inoperable. Indeed, there a numerous means for rebutting a *prima facie* case of obviousness.

Furthermore, Applicants previously explained that the Examiner failed to establish a *prima facie* case of obviousness because (1) the applied references are non-analogous art and (2) the Examiner failed to establish why one of ordinary skill in the art would have combined the references (i.e., the Examiner failed to consider the standard set forth in *KSR*).

Therefore, the burden has not shifted to the Applicants.

The Examiner further added, “[t]he Applicant asserts, instead, that the term “or combination thereof” only exists in claim 17 of Grider. One should should (*sic*) realize that, (*sic*) the claim is part of the disclosure as well.” (See Advisory Action dated May 19, 2009 at continuation page). The Examiner, however, has clearly misunderstood Applicants argument.

Applicants do not dispute that the claims of Grider are part of the disclosure of Grider. Applicants argued that the words “or combination thereof” is insufficient to provide the required reasoning and rationale underpinning required by *KSR*. Again, it is insufficient for the Examiner to establish that a secondary reference teaches a feature that is missing from the primary reference. Indeed, the Examiner must establish why one of ordinary skill in the art would have combined the feature of the secondary reference with the teachings of the primary reference.

Moreover, the Examiner states, “Applicant further ads: (*sic*) ‘thus, Grider does not provide any reason for introducing a combination of halogen species nor does Grider disclose or suggest any advantage that is achieved by introducing a combination of halogen chemistries.’ Not that, it is exactly similar to the instant disclosure. The Applicant does not offer any advantage of adding bromide containing gas.” (See Advisory Action dated May 19, 2009 at continuation page). The Examiner, however, has misunderstood the standard for establishing a *prima facie* case of obviousness.

That is, it is insufficient for the Examiner to establish that a secondary reference teaches a feature that is missing from the primary reference. Indeed, the Examiner must establish why one of ordinary skill in the art would have combined the feature of the secondary reference with the teachings of the primary reference.

Whether the application provides an advantage for a claim feature is irrelevant to

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whether the Examiner has established that one of ordinary skill in the art would have combined features from two alleged prior art references. Indeed, when attempting to establish a prima facie case of obviousness, the Examiner must not consider the teachings of the present application. In other words, the focus should be on the prior art references, not the application.

Applicants have added new claims 32 and 33 to claim additional features of the invention and to vary the protection for the claimed invention further. These claims are independently patentable because of the novel and non-obvious features recited therein.

New claims 32 and 33 are patentable over the cited prior art references at least for analogous reasons to those set forth above with respect to claims 1, 2, 5, 6, 11, 12, 14, 15, 17, 19-23, 25, and 26.

In view of the foregoing, Applicants submit that claims 1, 2, 5, 6, 11, 12, 14, 15, 17, 19-23, 25, 26, 32, and 33, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. Applicants respectfully request the Examiner to pass the above application to issue at the earliest possible time.

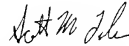
Should the Examiner find the application to be other than in condition for allowance, Applicants requests the Examiner to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

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The undersigned authorizes the Commissioner to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

Date: June 9, 2009



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